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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,358	10/07/2003	Frank J. Schwab	MSDI-245/PC819.00	S654
52196	7590	07/19/2007	EXAMINER	
KRIEG DEVAULT LLP ONE INDIANA SQUARE, SUITE 2800 INDIANAPOLIS, IN 46204-2709			WOODALL, NICHOLAS W	
		ART UNIT	PAPER NUMBER	
		3733		
		MAIL DATE	DELIVERY MODE	
		07/19/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/680,358	SCHWAB ET AL.	
	Examiner	Art Unit	
	Nicholas Woodall	3733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 23 April 2007.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1,3-27,29-40 and 49-52 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 11 and 27 is/are allowed.

6) Claim(s) 1,3-9,12-14,17-26,29,37-40,49 and 51 is/are rejected.

7) Claim(s) 10,15,16,30-36,50 and 52 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 23 April 2007 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>04/23/2007</u>	5) <input type="checkbox"/> Notice of Informal Patent Application 6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

1. This action is in response to applicant's amendment received on 04/23/2007.

### ***Allowable Subject Matter***

2. The indicated allowability of claims 4-8 and 23-25 is withdrawn in view of the newly discovered reference(s) to Moskovich. Rejections based on the newly cited reference(s) follow. The indicated allowability of claims 12-14, 21, and 27-29 is withdrawn.

### ***Drawings***

3. The drawings were received on 04/23/2007. These drawings are acceptable.

### ***Claim Objections***

4. Claims 19 and 27 are objected to because of the following informalities: claims 19 and 27 states, an instrument for inserting an instrument. The examiner believes this is meant to be an instrument for inserting an implant and will be understood as such for examination purposes. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1, 19, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding claims 1 and 21, the claims state that the guide flanges are aligned with a side of the other guide member that is opposite the side of the other guide

member including the guide flange. The examiner is unclear regarding the limitation the applicant is trying to convey with the claim language mention above. The examiner will interpret the claim language as follows for examination purposes, a first guide flange is aligned with a side of the first guide member and a second guide flange is aligned with a side of the second guide member, wherein the first and second guide flanges are on opposite sides of the first and second guide members.

8. Claim 19 recites the limitation "said first and second sides" in line 7. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 9, 12-14, 17-21, 26, 29, and 37-40 are rejected as understood under 35 U.S.C. 102(b) as being anticipated by Weissman (U.S. Patent 4,758,159).

Regarding claim 1, Weissman discloses a device comprising a proximal portion including a frame and a distal portion including first and second guide members extending distally from the frame (see Figure 1 below). The first and second guide member include opposite first and second sides extending between a proximal end and a distal end, a guide surface extending from the proximal end to the distal end between the first and second sides, and a guide flange extending along only one of the first and second sides projecting from a guide surface of the corresponding one of the first and

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second guide members toward the guide surface of the other of the first and second guide members, wherein the guide surfaces of the first and second guide members oriented towards each other, a first guide flange is aligned with a side of the first guide member and a second guide flange is aligned with a side of the second guide member, wherein the first and second guide flanges are on opposite sides of the first and second guide members. The examiner believes that when the device of Weissman is viewed from the distal end the guide members from L-shapes. The examiner believes that the guide flange of one guide member is on the right side of the guide member and the guide flange of the other guide member is on the left side of the guide member.

Regarding claim 9, Weissman discloses a device wherein guide surfaces are planar.

Regarding claim 12, Weissman discloses a device wherein the frame includes a stationary arm and a moveable arm, wherein one of the first and second guide members is coupled to the stationary arm and the other of the first and second guide members is coupled to the moveable arm. Regarding claim 13, Weissman discloses a device wherein the stationary arm and the moveable arm are transversely oriented to the first and second guide members. The examiner believes that the first and second guide members are transversely oriented to the surfaces of the stationary arm and the moveable arm from which the first and second guide members extend. Since the first and second guide members are transversely oriented to the surfaces of the stationary arm and the moveable arm the examiner believes that the first and second guide members meet the limitation of being transversely oriented with the stationary arm and the moveable arm. Regarding claim 14, Weissman discloses an element extending from

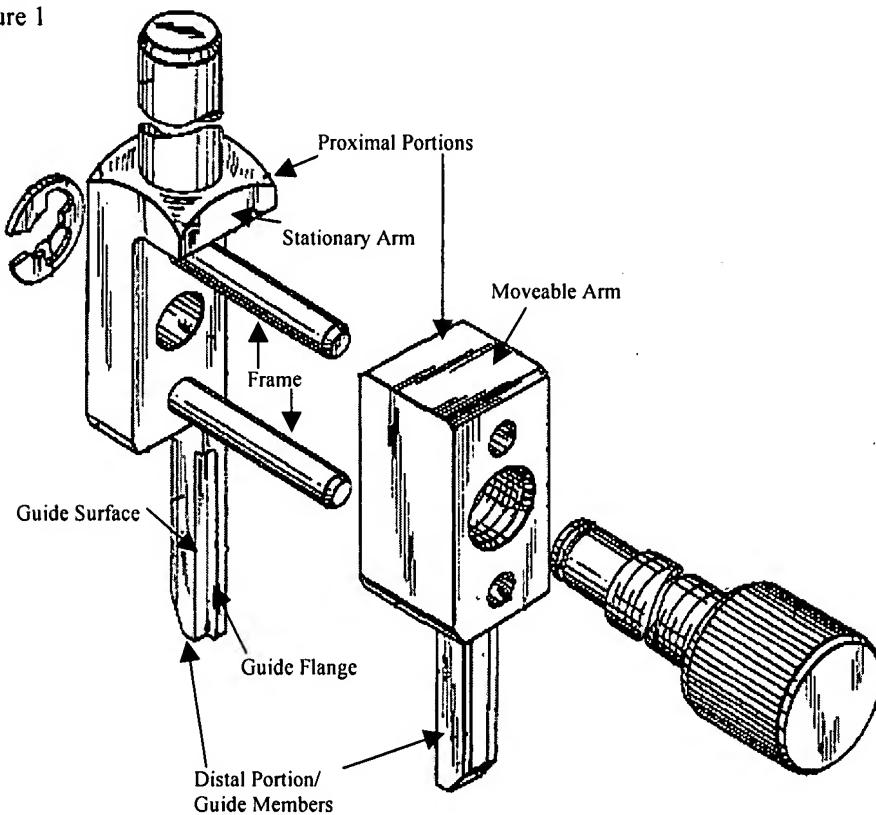
the stationary arm that is capable of being used as a handle. Regarding claim 17, Weissman discloses a device wherein the guide surfaces are parallel with one another. Regarding claim 18, Weissman discloses a device wherein the frame portion is capable of moving the guide members away from and toward one another while keeping the guide surfaces parallel. Regarding claims 19 and 20, Weissman discloses a device comprising a proximal portion including a frame and a distal portion including first and second guide members extending distally from the arms of the frame. The frame includes a stationary arm and a moveable arm coupled to the stationary arm, wherein the stationary arm and the moveable arm are transversely oriented to the first and second guide members as discussed above. The first and second guide members include a proximal end, a distal end, a first side, a second side, and a guide surface extending from the proximal end to the distal end between the first and second sides, wherein the guide surface of the first and second guide members are oriented towards one another. The first and second guide members are capable of moving toward and away from one another by moving the moveable arm relative to the stationary arm. Further regarding claim 20, Weissman discloses a device wherein the guide flange extends along only one of the first and second sides, the guide flange projecting from the guide surface of the corresponding guide member towards the guide surface of the other guide member. Regarding claim 21, Weissman discloses a device wherein a first guide flange is aligned with a side of the first guide member and a second guide flange is aligned with a side of the second guide member, wherein the first and second guide flanges are on opposite sides of the first and second guide members as discussed

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above. Regarding claim 26, Weissman discloses a device wherein the guide surfaces are planar. Regarding claim 29, Weissman discloses an element extending from the stationary arm that is capable of being used as a handle. Regarding claim 37, Weissman discloses a device wherein the guide surfaces are parallel with one another and the frame portion is capable of moving the guide members away from and toward one another while keeping the guide surfaces parallel. Regarding claim 38, Weissman discloses a device comprising a proximal portion including a frame and a distal portion including first guide member and a second guide member extending along the first guide member. The frame is coupled to the first and second guide members capable of moving the first and second guide members away from one another with the guide surfaces remaining generally parallel, wherein the frame is transversely oriented to the guide members adjacent the proximal ends of the guide members and the guide members define a proximal opening in between capable of receiving an implant for positioning between the guide surfaces of the guide members. The first and second guide members include a guide surface oriented toward the guide surface of the other guide member, wherein the guide surfaces are generally parallel with one another. Regarding claim 39, Weissman discloses a device wherein the frame includes a stationary arm coupled to one of the first and second guide members and a moveable arm coupled to the other of the first and second guide members, wherein the moveable arm is capable of being movably coupled to the stationary arm. Regarding claim 40, Weissman discloses a device wherein the guide members include guide flanges

extending along the guide members capable of confining an implant between the guide flanges as the implant is moved along the guide surfaces.

Figure 1

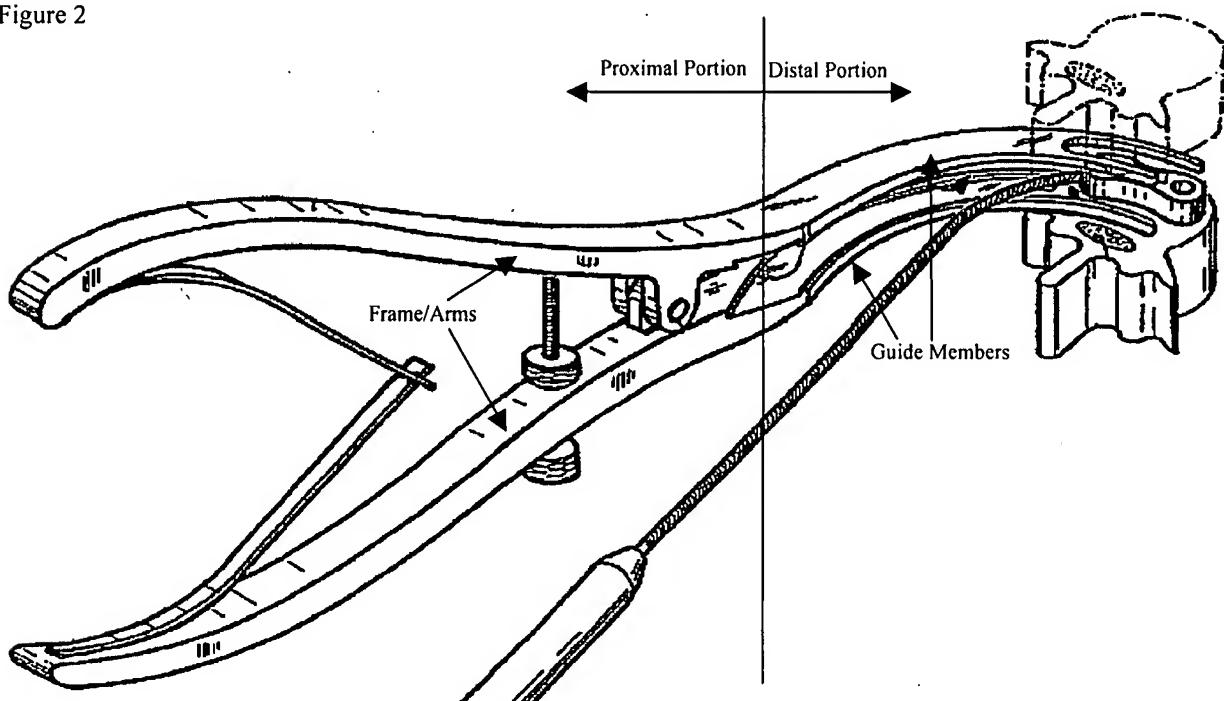


11. Claims 49 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuss (U.S. Publication 2002/0045904).

Regarding claim 49, Fuss discloses a device comprising a proximal portion including a frame with a first arm and a second arm and a distal portion including first and second guide members extending distally from the first and second arms, wherein are capable of being moved toward and away from one another by moving the first arm relative to the second arm (see Figure 2 below). The first and second guide members include opposite first and second sides extending between a proximal end and a distal

end, a guide surface extending from the proximal end to the distal end between the first and second sides and being oriented toward the guide surface of the opposite guide member, and a width between the first and second sides greater than the width of an implant to be positioned between the guide surfaces. Regarding claim 51, Fuss discloses a device wherein the first arm is capable of being moved and the second arm is stationary.

Figure 2



***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 3-8 and 22-25 are rejected as understood under 35 U.S.C. 103(a) as being unpatentable over Weissman (U.S. Patent 4,758,159) in view of Moskovich (U.S. Patent 5,431,658).

Regarding claims 3-8 and 22-25, Weissman discloses the invention as claimed except for the guide members including an abutment member adjacent the distal end, a support member extending distally from the abutment member, and the guide surfaces including a plurality guide rails. Moskovich teaches a device comprising an abutment member adjacent the distal end of the guide members, a support member extending distally from the abutment member, and the guide surfaces including a plurality of guide rails in order to limit the insertion of the guide members into the patient, to distract two sections of bone, and to prevent the implant from rotating or slipping. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Weissman wherein the guide members include an abutment member adjacent the distal end, a support member extending distally from the abutment member, and the guide surfaces including a plurality of guide rails in view of Moskovich in order to limit the insertion of the guide members into the patient, to distract two sections of bone, and to prevent the implant from rotating or slipping.

Regarding claims 6 and 25, the combination of Weissman and Moskovich disclose a device wherein the guide rails terminate at a location along the guide surface adjacent the abutment member.

***Allowable Subject Matter***

14. Claims 11 and 27 are allowed.

15. Claims 10, 15, 16, 30-36, 50 and 52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

16. Applicant's arguments with respect to claims 1, 3-27, 29-40, and 49-52 have been considered but are moot in view of the new ground(s) of rejection. The examiner has presented new grounds for rejection and withdrawn previously indicated allowability as discussed above making this office action non-final.

***Conclusion***

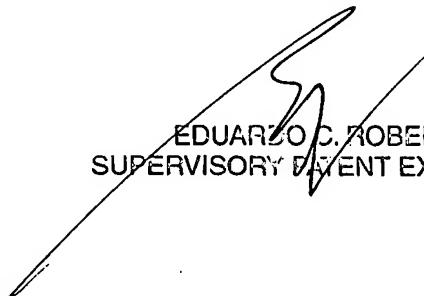
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



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